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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/846,834

05/01/2001

Mari Tateishi

TSL1469CIP

4974

137

7590

10/22/2003

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EXAMINER

CROSS, LATOYA I

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 10/22/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-12

Office Action Summary

Application No.

09/846,834

Applicant(s)

TATEISHI ET AL.

Examiner

LaToya L. Cross

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to Applicants' amendment filed on August 1, 2003 and entered as Paper No. 11. Claims 1-6 and 13 are pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese publication 10-251517 to Akamatsu et al.

Akamatsu et al disclose a vibration damping composition comprising 100 pts.wt. viscous liquid and 5-200 pts.wt. solid powder. The viscous liquid is preferably silicone oil, as recited in claim 2. The oil has a viscosity of 100-1,000,000 centistokes (100-1,000,000 mm²/s), as recited in claim 3. The solid powder has an average diameter size of 0.1-100 microns, as recited in

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claims 5 and 6. The particles are also of differing diameters – 1 wt.% or less of the powder has a diameter size of less than 10 microns and 10 wt.% or more of the powder has a diameter size of greater than 30 microns. The particle sizes differ by at least 20 microns, as recited in claim 4. The powders may be inorganic powders, calcium carbonate powders or organic resin powders. At paragraph 6 of the translated reference, Akamatsu et al disclose that a combination of powders may be used, such as polyethylene resin powder and silica powder. Further, Akamatsu et al also disclose the use of glass powder.

Akamatus et al fail to teach a combination of calcium carbonate with a different powder having a different particle size. Further, Akamatus et al fail to teach using calcium carbonate in combination with glass powder.

While the reference may not teach calcium carbonate specifically in combination with another powder, the reference does disclose using a combination of powders, such as a combination of polyethylene resin powder and silica powder. Given this disclosure, it would have been obvious to one of ordinary skill in the art to use any combination of powders disclosed, especially since the reference teaches on a small group of powders. Both calcium carbonate and glass powders are disclosed. It would have been obvious to use these powders to achieve enhanced vibration damping characteristics even where there is a change in the frequency of vibration as disclosed by Akamatus et al.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be anticipated, within the meaning of 35 USC 103 in view of the teachings of Akamatsu et al.

Response to Arguments

4. Applicant's arguments filed August 1, 2003 have been fully considered but they are not persuasive. With respect to the rejection over Akamatsu et al, Applicants argue that the reference fails to teach using two different powders having two different particle sizes, wherein one of the powders is calcium carbonate. The Examiner disagrees. At paragraph 6 of the translated version of the reference, Akamatsu et al teach using a combination of powders, such as polyethylene resin powders and silica powders. While the examples of the reference are directed to using only one powder having different particle sizes, it is improper for Applicants to rely only on the examples of the reference. The teachings of the entire reference must be considered and taken as a whole. Both calcium carbonate and glass powders are disclosed in the reference. Further, the reference discloses using a combination of powders, where only five powders are disclosed – a group small enough such that the skilled artisan could feasibly choose calcium carbonate and glass powders to include in the vibration damping composition.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 703-305-7360.


The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 703-308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

The Art Unit is tentatively scheduled to move around December 16, 2003. If during the month of December, Applicants may attempt to contact the Examiner at (571) 272-1256 or the Examiner's supervisor at (571) 272-1267.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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October 20, 2003


Jill Warden
Supervisory Patent Examiner
Technology Center 1700